



NEIFELD REF.: DEATON-18-USC1

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: DEATON ET AL.

USPTO CONFIRMATION CODE: 8230

SERIAL NO: 08/935,116

FILED: 9/22/1997

EXAMINER: ALVAREZ, Raquel

GROUP ART UNIT: 3622

FOR: System, method and Database for Processing Transactions

37 CFR 1.142 RESPONSE TO OFFICE ACTION CONTAINING A REQUIREMENT TO
ELECT

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

Sir:

Please consider this response to the office action dated 5/13/05.

In response to the requirement to elect between claims 8-16 and 17-76, the applicant elects claims 8-16, with traverse for four reasons.

First, the examiner's requirement to elect violates 37 CFR 1.142(a); this application is long after final, and after a decision on appeal on claims 8-39. 37 CFR 1.142(a) precludes a requirement to elect after final. Accordingly, the examiner's requirement to elect is improper and must be withdrawn.

Second, the examiner's requirement to elect is also improper given the long pendency of this applications and its claims. The examiner should be equitably estopped from requiring election because that will result in loss of significant patent term, on the order of 5 years, due to the tardiness of the requirement.

Third, the examiner's requirement lack s merit. The examiner admits that both sets of claims are classified in class 705, subclass 26 showing no basis for any burden in search on the examiner. A showing of burden, in addition to an actual burden, are prerequisites for a sustainable requirement to elect. See section III.C.6 in "Continuation Applications, RCEs, Appeals, Petitions, Interferences, Public Use Proceedings, Determinations, and Oppositions Neifeld, published in Proceedings of "Practical Patent Prosecution Training for New Lawyers," (AIPPLA 2004)." The examiner provides no such showing.

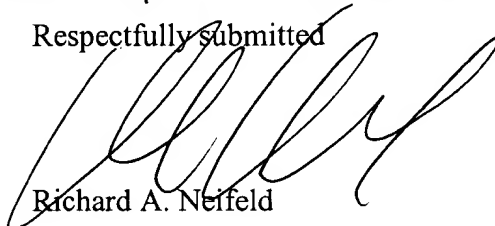
Fourth, the assertions of fact in support of the examiner's sole rationale in support of the requirement to elect are incorrect. The examiner states that allegedly distinct inventions I and II are related as sub combination of one another, *and distinct because* "invention II has the separate utility such as associating a customer number with a dollar amount."

The foregoing quoted assertion is incorrect. Alleged Invention II is not a *sub combination* of invention I with respect to customer number and dollar amount. It is instead a *species* thereof, because the associating dollar amount with customer identification of alleged invention II is covered by, and a subset of, alleged invention II's "information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion" associated with the costumer identification of group I. Thus, the utility of associating a dollar amount with a customer number is generic to the allegedly distinct Invention I. In other words, the subject matter upon which the examiner allegedly distinct invention I and

It are distinct, is common to both allegedly distinct inventions. Therefore, the inventions cannot be distinct in the manner asserted by the examiner.

For all of the foregoing reasons, the requirement is improper and should be withdrawn.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'Richard A. Neifeld', written over the typed name.

Richard A. Neifeld

Registration No. 35, 299

Attorney of record

Printed: May 16, 2005 (7:46pm)

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